

awarding the player a separate payout for winning outcomes of the first wagering segment game and winning outcomes of the second wagering segment game, and where there are consecutive winning outcomes for the first wagering segment game and the second wagering segment game, awarding the player a third payout without placing further wagers in addition to the wager comprising at least one part.

**REMARKS CONCERNING THE AMENDMENTS MADE IN THE
AMENDMENT FILED ON AUGUST 21, 2002**

The amendments were made in that earlier amendment to more clearly define the present invention and to address issues raised in the Office Action. The majority of amendments address minor internal references within claims (e.g., “second hand of cards” and “both the” added to the claims, even though the meaning and presence of those terms was understood to already be in the claims. Additionally, the phrase “without having placed an additional bet” added to claims 1, 4 and 15 further clarifies the scope of the present invention, further emphasizing the meaning of the phrase “resolving the at least one bet”.

SUMMARY OF THE REJECTIONS

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Rejections Under 35 USC 112, Second Paragraph

The previous rejections under 35 USC 112, Second Paragraph have been withdrawn.

Rejections Under The Judicially Created Doctrine of Double Patenting

All claims have been rejected under a purported Judicially Created Doctrine of Double Patenting over the claims of U.S. Patent No. 6,179,711 in view of Ornstein. The accompanying Terminal Disclaimer is effective against Obviousness-Type Double patenting.

Rejections Under 35 USC 103(a)

Claims 1-19 and 22-37 have been rejected under 35 USC 103(a) as unpatentable over Williams in view of Ornstein (US Patent No. 5,570,885). It is asserted that Williams teaches every limitation of the claims except for “resolving a bet with respect when both first and second set of symbols exceed a minimum rank in the pay table.”

It is asserted that as Ornstein teaches a method of playing a game where a payoff is made for consecutive winnings, one of ordinary skill in the art would have made the Williams game more attractive for players by making an additional payoff for winning two or more plays consecutively. It is therefore asserted that it would have been obvious to modify the game of Williams to allow for the enhanced play taught by Ornstein. Claim 20 has been finally rejected under 35 USC 103(a) as unpatentable over Netley in View of Ornstein. It is asserted that Netley shows every element of the claimed invention except for “paying for a parlay or consecutive winnings on hands.” It then is asserted that as Ornstein teaches a wagering game allowing a player to win multiple bets for consecutive winning hands, it would be obvious to modify the game of Netley to allow for the enhanced play taught by Ornstein.

RESPONSE TO THE REJECTIONS

(Obviousness-Type) Double Patenting

Claim 1 of U.S. Patent No. 6,179,711 is:

1. A method of scoring a video wagering game, the game comprising at least a first and second segment, the method comprising the steps of:
 - placing a wager to participate in a video wagering game;
 - playing the first segment of the video wagering game;
 - continuing play of the first segment until at least one predetermined condition has been met;**
 - assigning a payout based on at least one winning outcome of the first segment;
 - playing the second segment of the video wagering game when the at least one predetermined condition has been met;**
 - wherein said payout of the first segment is enhanced by a factor determined by an outcome in the second segment, and wherein the factor is at least one;**
 - multiplying the payout of the first segment by the factor determined in the second segment; and**
 - paying the enhanced payout to the player.

This rejection is not understood, as the games recited in the present claims are quite distinct from the elements of the method recited in the claims of U.S. Patent No. 6,179,711. Significant elements of the Patent claim that are not present in the play of the present method (in any claims) are highlighted.

The highlighted portions are not present in the recited method because:

continuing play of the first segment until at least one predetermined condition has been met;

1) There is no predetermined condition that is a condition precedent for any additional play, as recited in the Patent claim.

playing the second segment of the video wagering game when the at least one predetermined condition has been met;

2) The second hand is always dealt and is always played in the presently claimed method. There is no condition precedent of "playing...when the at least predetermined condition has been met." The second set of symbols or the second game is always played.

wherein said payout of the first segment is enhanced by a factor determined by an outcome in the second segment, and wherein the factor is at least one;

3) The second game does not determine factors. The second game (e.g., the second set of symbols or second hand) is independently awarded on the basis of its rank according to the pay table. No factor is determined.

multiplying the payout of the first segment by the factor determined in the second segment;

4) There is no multiplication of the first award by a factor determined in the second game event. The first payout is not multiplied. That amount is paid out (resolved in step a) by itself. The other events are separately paid out.

It is absolutely clear that the two processes (of the patented claims and the present claims) do not overlap. The present claims could not have been recited in the Patent, as the present claims are a distinct invention not even within the generic scope of the claims of the Patent, and the subject matter of the present process was not disclosed in the specification of the patent.

The rejection for Double Patenting or Obviousness-Type Double Patenting is completely in error. In the event that the PTO continues with this rejection, a Terminal Disclaimer has been provided to overcome the rejection.

Rejections Under 35 USC 103(a)

Rejection of Claims 1-19 and 22-37 Under 35 USC 103(a) As Unpatentable Over Williams In View of Ornstein

This rejection is in error, even if the references are combined in the manner proposed by the Examiner. Each of these claims contains essentially the same limitations:

“...placing at least one bet...” or “...placing at least a one part bet...”; and
“...playing a second wagering game segment whose outcome is based at least in part on chance without placing further wagers in addition to the wager comprising at least one part...” (or the least one bet).

The significance of this difference is that Ornstein requires that a second bet be placed **after the play of the first hand and before play of the second hand, so that the limitation of playing a second wagering game segment...without further placing wagers in addition to the at least one part IS NOT TAUGHT BY ORNSTEIN.** Note for example, column 4, lines 26-32 where Ornstein states:

“After the play of the first hand and assuming that the player making the bets in Fig. 3a has a winning hand, a streak chip S, which is under the control of the dealer, is placed in region C2 by the dealer. The player’s original bet is paid off and the player then makes another original bet preparatory to the initiation of the second play, as shown in Fig 3b.”

Additionally, the play of the game remains the same (including originating wagers in each game) with each variety of game played, as stated by Ornstein on column 5, lines 51-56; and column 6, lines 25-32. In every description of the games, the play of the underlying game remains the same for the same game, which includes the originating bet in the game, whether the first game or the second game.

Ornstein therefore clearly teaches away from the specific limitation that applicants assert for patentability with respect to the limitations in the independent claims recited above, the requirement that no additional bet be made. As Ornstein specifically teaches that a second bet is to be made prior to play of the second game, the reference, either alone or in combination with Williams, does not teach the actual limitations of the claims.

The rejection of claims 1-19 and 22-37 as unpatentable Williams in view of Ornstein is therefore clearly in error.

Rejection of Claim 20 Under 35 USC 103(a) Over Netley in View of Ornstein

It is asserted that Netley shows every element of the claimed invention except for “paying for a parlay or consecutive winnings on hands.” It then is asserted that as Ornstein teaches a wagering game allowing a player to win multiple bets for consecutive winning hands, it would be obvious to modify the game of Netley to allow for the enhanced play taught by Ornstein.

Netley does not show every element of the claims (the claim that is believed to be the broadest claim of this application, Claim 1, will be examined in this light), except for the parlay wager. In fact, Netley shows a traditional parlay type wager that is excluded from play of the present game. A side-by-side comparison of Netley and the claimed play (with comments) would be helpful in detailing the differences.

Claim 1 of Application	Netley Disclosure	COMMENTS
1. A method of playing a wagering game with at least two consecutive plays comprising:	Netley has consecutive plays only after a win in a first hand and an election to wager on a second, bonus-type round.	The preamble requires the underlying game to have at least two consecutive hands. There may not be only an optional or bonus play.
Placing at least one bet;	At least one bet is placed.	Same step
receiving at least one first set of symbols from which a rank may be determined in reading the symbols;	Netley receives a hand of cards from which a rank may be determined.	Same step
determining the rank of the first set of symbols;	A rank is determined.	Same step
comparing the first set of symbols to a payout table;	A payout table is used to determine an amount of win	Same step
determining whether the rank of the first set of symbols exceeds a minimum rank in the payout table;	A minimum rank on the payout table is determined in comparison with the hand.	Same step
receiving at least a second set of symbols from which a rank may be determined without having placed an additional bet;	Netley provides a second hand only with a “win” in the first hand.	This step is a required, not optional step in the invention. Even with a win in Netley, this is optional. Without a win, there is no second hand.
determining the rank of the second set of symbols;	A rank is determined in the second hand.	Same Step
comparing the rank of the second set of symbols to a payout table;	A payout table is used to determine an amount of win	
determining whether the	A minimum rank on the	

rank of said second set of symbols exceeds a minimum rank in the payout table;	payout table is determined in comparison with the hand.	
resolving the at least one bet with respect to whether a) the first set of symbols exceeds a minimum rank in the payout table;	The first bet of Netley is resolved with respect to the first set of symbols and the first pay table.	It is important to note that a distinct bet is made by Netley for the first hand and second hand. If the player wins the first hand, he can "either accept payment...or....wager the amount on a second tier poker hand. Col. 1, lines 45-52.
b) the second set of symbols exceeds a minimum rank in the payout table;	The distinctly separate second bet of Netley is resolved with regard to the second set of symbols.	The claims of the invention require that the at least first bet is resolved with regard to the second set of symbols.
and c) <u>both the</u> first set of symbols and the second set of symbols exceed a minimum in the payout table.	There is no third resolution in Netley. There are at most two resolutions on two hands. Payout for the first hand and payout for the second hand.	This concept of three payouts is absent from Netley. Netley is literally no more than a true parlay series of play, with an election of the amount to parlay.

Ornstein does not cure the deficiencies of Netley. Ornstein merely describes a side bet game on the occurrence of consecutive wins in a base game, such as the game of blackjack. It does not require the player to participate in a second game without having placed an additional bet, and it does not provide an additional bonus payout for wins on both base games.

Applicants assume the application is now in proper order and in condition for allowance. Please direct any inquiries to the undersigned attorney at (952) 832-9090.

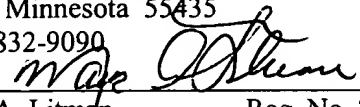
Respectfully submitted,

MARK YOSELOFF

By their Representatives,

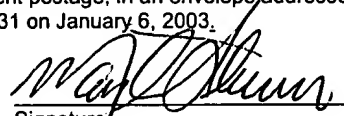
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Date: 6 January, 2003

By: 
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CERTIFICATE UNDER 37 C.F.R. 1.8: The undersigned hereby certifies that this Letter is being deposited in the United States Postal Service, as first class mail, with sufficient postage, in an envelope addressed to: BOX AF, Assistant Commissioner for Patents, Washington, D.C. 20231 on January 6, 2003.

Mark A. Litman
Name


Signature